

REMARKS

A. Status of the Claims

Claims 1, 2, 12, 14, 25 and 26 were examined and remain pending. No amendments have been made.

B. Claims 1, 2, 25 and 26 Are Patentable Over Stinson

The Office rejects claims 1, 2, 25, and 26 as being obvious over US 6,340,367 to Stinson. Each of these claims involve a “non-radio opaque securing material,” which the Office admits that Stinson fails to teach. However, the Office attempts to cure this deficiency by relying on *Applicant’s* teachings rather than the teachings of the prior art:

[I]t would have been obvious to one of ordinary skill in the art at the time the invention was made to use a radiopaque material or non-radiopaque material because the *applicant* has shown that either material are well known variants of each other.

Action at p. 3 (emphasis added). This is classic, impermissible hindsight. *See Ex parte Utter*, Appeal No. 2002-0263, Slip Op. at 6 (“Clearly we have before us a rejection evidencing a classic hindsight reconstruction since the only basis whatsoever for completely reworking the Goda device for achieving the claimed invention from the applied prior art, as proposed by the examiner, would be impermissible hindsight reliance *upon appellants’ own teaching in the present application. It is for this reason that the rejection cannot be sustained.*”) (emphasis added). Moreover, there is no motivation for replacing Stinson’s radio opaque material with non-radio opaque material because radiopacity is Stinson’s focus. Eliminating it would render Stinson unsuitable for its intended purpose. MPEP 2143.01 at 2100-129. For these reasons, the rejection is overcome and Applicant respectfully requests that it be withdrawn.

C. Claims 12 and 14 Are Patentable Over Stinson and Ashley

The Office rejects claims 12 and 14 as obvious over Stinson in view of The Ashley Book of Knots. Even assuming it is proper to combine the tying teachings of The Ashley Book of Knots with Stinson, this does not cure Stinson's shortcoming or the lack of a motivation in the prior art to replace Stinson's radiopaque material with a non-radio opaque material, a change that would render Stinson unsuitable for its intended purpose. MPEP 2143.01 at 2100-129. Accordingly, the obviousness rejection is overcome and Applicant respectfully requests that it be withdrawn.

D. Conclusion

Claims 1, 2, 12, 14, 25 and 26 are in condition for allowance. Should Examiner Erez have any questions, comments, or suggestions relating to this application, he is invited to contact Applicant's attorney at (512) 536-3031.

Respectfully submitted,

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